TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/385,607
Filing Date	8/30/1999
First Named Inventor	William M. Parrott
Art Unit	2137
Examiner Name	Callahan, P.
Attorney Docket Number	42390.P12216

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ENCLOSURES   *(Check all that apply)*

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  - [✓] Fee Attached
- [ ] Amendment/Reply
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  - [ ] Affidavits/declaration(s)
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- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
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- [ ] Drawing(s)
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- [ ] Petition to Convert to a Provisional Application
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Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Intel Corporation
Signature	
Printed name	Stuart A. Whittington
Date	November 28, 2005

Reg. No.	48,216

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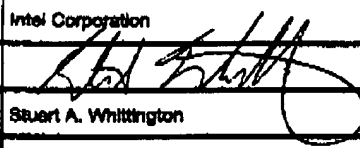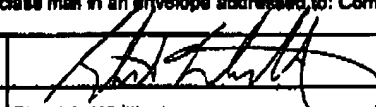| Date	November 28, 2005

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FEE TRANSMITTAL
For FY 2005

Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818)

☐ Applicant claims small entity status. See 37 CFR 1.27

| TOTAL AMOUNT OF PAYMENT | ($) | 500.00 |

Complete if Known	
Application Number	09/386,807
Filing Date	8/30/1999
First Named Inventor	William M. Parrott
Examiner Name	Callahan, P.
Art Unit	2137
Attorney Docket No.	42390.P12216

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES Fee ($)	FILING FEES Small Entity Fee ($)	SEARCH FEES Fee ($)	SEARCH FEES Small Entity Fee ($)	EXAMINATION FEES Fee ($)	EXAMINATION FEES Small Entity Fee ($)	Fees Paid ($)
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

2. EXCESS CLAIM FEES

Fee Description	Fee ($)	Small Entity Fee ($)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee ($)	Fee Paid ($)
_____ - 20 or HP =	_____ x	_____ =	_____

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee ($)	Fee Paid ($)
_____ - 3 or HP =	_____ x	_____ =	_____

HP = highest number of independent claims paid for, if greater than 3.

Multiple Dependent Claims	
Fee ($)	Fee Paid ($)
_____	_____

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee ($)	Fee Paid ($)
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4. OTHER FEE(S)

	Fees Paid ($)
Non-English Specification, $130 fee (no small entity discount)	
Other (e.g., late filing surcharge): Appeal Brief -Fee Code: 1402	500

SUBMITTED BY

Signature	Registration No. (Attorney/Agent) 45, 215	Telephone 480.715.3895
Name (Print/Type) Stuart A. Whittington		Date November 28, 2005

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
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....

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of William M. Parrott

Appln. No.: 09/385,607

Filed: August 30, 1999

Title: SECURE TRANSACTION MODEM STORING UNIQUE INDICIA

Atty. Docket No: (Old: 008193-20001)
                (New: 42390.P12216)

Group Art Unit: 2137

Examiner: Callahan, Paul E.

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON APPEAL

Pursuant to Appellant's Notice of Appeal filed on September 26, 2005, Appellant presents this Brief in appeal of the Final Rejection dated March 24, 2005.

I.   REAL PARTY IN INTEREST.

Intel Corporation is the real party in interest.

II.   RELATED APPEALS AND INTERFERENCES.

There are no related appeals or interferences before the Board of Patent Appeals and Interferences or related judicial proceedings known to Appellant, the Appellant's legal representatives, or assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

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U.S. Appln. No. 09/385,607

III.   STATUS OF CLAIMS.

Claims 1-27 have been pending in the application. Claims 22-27 have been cancelled

leaving claims 1-21 as the only pending claims remaining. Claims 1-21 stand finally rejected

and are the claims subject to this appeal, which are reproduced in Appendix A.

IV.   STATUS OF AMENDMENTS.

Appellant submitted an Amendment on June 23, 2005 subsequent to the Final Office

Action of March 24, 2005. The Amendment only presented two proposed drawing changes to

address specific drawing objections in the Final Office Action. No amendments to the claims

were presented. In the Advisory Action dated August 5, 2005, it was indicated that Appellant's

amendment would not be entered prior to Appeal because it raised new issues requiring further

consideration and raised the issue of new matter. The Board is respectfully requested to instruct

that this amendment be entered as no new issues or new matter have been presented as Appellant

has only attempted to comply with the specific requests made in the Office Action.

V.   SUMMARY OF CLAIMED SUBJECT MATTER.

The inventive embodiments generally relate to secure online transactions conducted with

a modem. (Specification pg. 1, ll. 12-13). The integrity of online transactions have been the

subject of much concern. There has been a growing need to authenticate or otherwise validate

the identify of participates in online commerce transactions. (Spec. pg. 1, ll. 19-20).

Embodiments of the present invention relate to a modem with integral identification indicia that

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can be accessed by communications software such as the operation software of the modem and

transmitted to a host to validate the identity of a user. (Spec. pg. 2, ll. 21-23).

Referring to Fig. 2, a modem 40 may include a microprocessor 26 to control operations

and manage communication with a host computer. Modem 42 may also include a memory (e.g.,

flash ROM 42) to provide storage space for storing indicia 44 of an identification of a user.

(Spec. pg. 12, ll. 13-20). The modem software is modified to transmit the identifying indicia,

preferably in encrypted form, when required to validate a transaction. By providing identifying

indicia within memory that can only be altered by overwriting the modem program, it becomes

difficult to counterfeit the identifying indicia or the secure modem. (Spec. pg. 13, ll. 4-11).

In one embodiment, the identifying indicia may be stored into modem 40 after the

manufacturing process and stored by, for example, a financial institution issuing the modem or

that will process the financial transactions. In a generalized embodiment, a compressed image or

other authentication indicia might be stored within a non-volatile memory. For example, an

image of a credit card including a credit card number and a signature could be stored in the

EEPROM of the modem (Spec. pg. 7, ll. 13-17).

In the example of Fig. 2, the identifying indicia may be stored in memory space 44 and

might be an image of a user's credit card, complete with signature and preferably the image of

the credit card holder stored in a widely accepted data format such as a .pdf format. (Spec. pg.

13, ll. 23 to pg. 14, ll. 1-3). The embodiments are therefore related to a personalized modem

capable of storing identifying indicia unique to the modem. (Spec. pg. 3, ll. 1-2).

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A method of communicating via modem 40 is also shown and described in reference to

Fig. 3 and pg. 14, ll. 7-13, which generally includes communicating the identifying indicia to a

transaction server 52 as needed to authenticate or validate a transaction. These specific

embodiments are provided by way of example and those of ordinary skill in the art will

appreciate that modification, variations and extensions of the particular embodiments are

possible without varying from the fundamental teachings of the present invention. (Spec. pg. 14,

ll. 15-19).

VI.   **GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.**

The only issue for consideration on this Appeal is:

A.   Whether claims 1-21 were properly rejected under the written description

requirement of 35 U.S.C. § 112 first paragraph as containing subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in the relevant art

that the inventor, at the time the application was filed, had possession of the claimed subject matter.

VII.   **ARGUMENT.**

A.   **APPELLANT'S CLAIMS ARE FULLY SUPPORTED BY THE
APPLICATION AS FILED.**

LEGAL STANDARD

It is well established that the objective standard for determining compliance with the

written description requirement is "does the description clearly allow persons of ordinary skill in

the art to recognize that he or she invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012

(Fed. Cir. 1989).

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In determining whether the description requirement is met, the examiner has the initial

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Appellant's specification generally discloses that a compressed image could be used for authentication purposes of the inventive embodiments (Spec. pg. 7, ll. 13-14) and that identifying indicia may be personalized to the user (Spec. pg. 3, ll. 1-2). Further, Appellant expressly describes an example identifying indicia to include an image of a credit card complete with signature and preferably the image of the account holder (Spec. pg. 13, ll. 23 to pg. 14, ll. 2). Appellant respectfully submits that simply because the disclosure discusses a preferred embodiment where various image information is be used for authentication purposes as a combination, it does not mean the skilled artisan would not recognize each could alternatively be used individually, particularly where each type of information that could be used is explicitly disclosed.

While admittedly, Appellant does not expressly describe all potential combinations or every individual type of graphics information that could possibly be used for authentication, Appellant believes the skilled artisan would clearly recognize from the disclosure that Appellant invented what is claimed, thus it is believed the objective test regarding compliance with the written description requirement is fully satisfied. Further, since there has been no attempt to explain why the skilled artisan would not recognize various images could be used other than in combination, particularly in light of the specification explicitly disclosing that variations and modifications to the specific embodiments are possible (Spec. pg. 14, ll. 15-19), Appellant believes the rejection under 35 U.S.C. § 112, first paragraph, is improper and should be overturned.

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Appellant lastly points out that, while not necessarily pertinent to the Board's decision, the limitations in question were individually presented by claim amendments (e.g., new claims 22-27) on December 13, 2003. The new claims were not only were entered into the record by the previous examiner (having signature authority) without objection, but were also indicated as including allowable subject matter. (See Appellant's amendment of December 17, 2003 and subsequent Office Action dated March 12, 2004). Appellant subsequently amended the claims of this application based on the previous examination record only to now find these claim limitations do not meet the written description requirement. Respectfully, Appellant believes it should be entitled to a reasonable degree of consistency in examination of the same application or, if the rejection is sustained, be entitled to a refund of all fees paid in the course of relying on the necessarily flawed examination record of a previous examiner.

VIII. CONCLUSION.

It is respectfully submitted that in view of the foregoing all of the pending claims are patentable and the Board is respectfully requested to overturn the rejection of record and allow this application to issue.

Respectfully submitted,

Stuart A. Whittington
Appellant's Attorney
Registration No. 45,215
Intel Corporation

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U.S. Appln. No. 09/385,607

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Date: November 28, 2005

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APPENDIX A
(Claims on Appeal)

1. (Previously presented) A secure communications method, comprising:

providing a modem capable of storing identifying indicia unique to the modem, wherein the identifying indicia includes graphics data, the graphics data comprising an image of at least one of a credit card, a signature, or an account holder; and

providing communications software stored within the modem, capable of transmitting identifying indicia to a communications line.

2. (Original) The secure communications method of claim 1, wherein the modem stores the identifying indicia integral to the modem.

3. (Original) The secure communications method of claim 2, wherein the identifying indicia comprises bits accessible by processing circuitry of the modem in a read operation, the process circuitry reading the bits prior to causing the bits to be transmitted over the communications line..

4. (Original) The secure communications method of claim 3, wherein the bits are stored within a memory array.

5. (Original) The secure communications method of claim 1, comprising a process for permanently fixing the identifying indicia in circuitry of the modem.

6. (Original) The secure communications method of claim 5, wherein the process for permanently fixing comprises blowing fuses.

7. (Original) The secure communication method of claim 5, further comprising encrypting the identifying indicia prior to causing the identifying indicia to be transmitted over the communications line.

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APPENDIX A
(Claims on Appeal)

8. (Original) The secure communications method of claim 1, wherein the identifying indicia are stored in the modem within a memory associated with a program memory of the modem.

9. (Previously presented) The secure communications method of claim 8, wherein the identifying indicia are writable only when the program memory is overwritten.

10. (Original) The secure communications method of claim 9, wherein the identifying indicia are formatted as compressed graphics data.

11. (Previously presented) A secure communications modem, comprising:

a program memory adapted to store a program controlling aspects of modem operation; and

a processor, coupled to the program memory, the processor executing at least a portion of a program stored in the program memory to control at least an aspect of modem operation,

the program adapted to cause the processor, under control of the program, to read identifying indicia stored integrally within the modem and communicate the identifying indicia to a host communicating with the modem, wherein the identifying indicia includes graphics data, the graphics data comprising and image of at least one of a credit card, a signature, or an account holder.

12. (Original) The modem of claim 11, wherein the identifying indicia are stored in an indicia memory physically or logically adjacent the program memory.

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APPENDIX A
(Claims on Appeal)

13. (Previously presented) The modem of claim 11, wherein the identifying indicia are stored in an indicia memory, the indicia memory writable only when program memory is written.

14. (Original) The modem of claim 11, wherein the identifying indicia are stored permanently within the modem.

15. (Original) The modem of claim 11, further comprising means for encrypting the identifying information prior to communicating the identifying information to the host.

16. (Original) The modem of claim 14, further comprising means for encrypting the identifying information prior to communicating the identifying information to the host.

17. (Original) The modem of claim 15 wherein the identifying indicia are stored within a write once memory array and are accessible in a register read operation by the processor.

18. (Original) The modem of claim 14, wherein the identifying indicia identify an aspect of a financial transaction account.

19. (Original) The modem of claim 11, wherein the identifying indicia include an account number for a financial transaction account.

20. (Original) The modem of claim 11, wherein the indentifying indicia are stored in nonvolatile memory within the modem.

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APPENDIX A
(Claims on Appeal)

21. (Original) The modem of claim 20, wherein the identifying indicia are stored in a compressed format.

Claims 22-27. (Cancelled)

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